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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,858	10/31/2003	Gary T. Scim	GUID.014US01(01-014)	9341

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EXAMINER	
SMITH, TERRI L	
ART UNIT	**PAPER NUMBER**
3762	

MAIL DATE	DELIVERY MODE
08/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/698,858	Applicant(s) SEIM ET AL.	
	Examiner Terri L. Smith	Art Unit 3762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED on 30 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires ______months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)); or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

TLS
3 August 2007

George Evanisko
Primary
8/5/7

Continuation of 11. does NOT place the application in condition for allowance because: With regard to Applicant's arguments, prosecution on the merits is closed.

Applicant repeated all of the arguments presented in the REMARKS filed on 16 October 2006. In response to these repeated arguments, Examiner maintains the arguments submitted in the Office Action filed on 25 May 2007, because Applicant's arguments are still not persuasive. Consequently, Examiner maintains both claim rejections 35 U.S.C. 102(e) as being anticipated by Levine et al., U.S. Patent 7,031,773 for claims 1–3, 10–19, 20, 24–27, 36–39, 44–55 and 59–62 and 35 U.S.C. § 103(a) as being unpatentable over Levine et al., U.S. Patent 7,031,773 for claims 4–8, 21–23, 28–29, 40–43 and 56–58 as set forth in said Office Action and as re-submitted herein below. The 35 U.S.C. § 103(a) claim rejection is being maintained in light of the claims' dependency on the rejection of their respective independent claims that has been maintained.

Additionally, Applicant's citings of case law on page 22 to rebut Examiner's 35 U.S.C. 112 second paragraph is moot because Exmainer maintains that Applicant continues to misinterpret the principle of claims being interpreted in the light of the specification. Applicant is reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to the disputed terms. Consequently, Examiner maintains claims 36–60 rejected under 35 USC § 112 second paragraph as set forth in the Office Action mailed on 12 July 2006. It is noted that claim 60 remains rejected under 35 USC § 112 second paragraph because it depends from claim 55 which depends from rejected claim 36.

Regarding Applicant's new argument on page 15 that: "The Applicant respectfully submits that when the claims are properly interpreted, it is not necessary to amend the independent claims, as they are already patentable in view of the teachings of the Levine reference", Examiner respectfully disagrees. Examiner has specifically cited in said Office Action every limitation of the claimed invention in the broadest reasonable interpretation consistent with the claimed invention. Examiner reiterates that Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 16 Applicant argued that: "The Applicant respectfully submits that one of ordinary skill in the art would readily understand that ATP therapy and auto-capture are distinct methodologies." Examiner continues to maintain that Levine et al. teache ATP, as defined on this same page 16 by Applicant, because Levine's device treats tachcardia as disclosed in column 9, line-column 10 line 5. Regarding Applicant's argument on this same page that: "Although Levine lists anti-tachycardia pacing amongst other tiered therapies (Col. 8, Lines 51-52), Levine's mere mention of anti-tachycardia pacing is unconnected with Levine's discussion of switching electrodes during auto-capture", Examiner respectfully disagrees as Levine et al. clearly disclose that the device performs ATP by the performance of micrcontroller 60 as taught in cited reference herein.

Continuing on page 16, regarding Applicant's argument that: "Levine does not disclose customizing specified parameters for a particular patient" is moot because "customizing specified parameters for a particular patient" is not being claimed.

Regarding Applicant's arguments on pages 16-18 that: "Claims 1, 36, and 61 each recite, among other limitations, some variation of an impedance threshold developed for a particular patient, which is not disclosed by Levine", Examiner respectfully disagrees. As recognized by the Applicant, Examiner cited where Levine et al. teach an impedance threshold developed for a particular patient on Page 3 of the Office Action. It is readily apparent that Levine additionally supports Examiner's position in column 12, lines 31-57 where the polarity of the electrodes is directly related to the impedance threshold.

In response to Applicant's discussion and argument on pages 18 and 19 regarding inherency, it is noted that the Examiner clearly pointed to the teachings in Levine et al. that disclose said claimed limitations. Examiner withdraws the portion of the argument regarding inherency as it is not required to substatiate the presence of the claimed limitations taught by Levine et al. Additionally, it is noted that Applicant selectively left out the the reference to the "amplitude" limitation in column 10 line 30 which is the most important citing for said limitation. The purpose of citing the "evoked response" in the three different locations was to tie it (the "evoked response") to the teaching of being based on the "amplitude" as cited in the claimed limitation.